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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,554	10/31/2000	Katsumi Nihei	Q61559	7384

7590 04/07/2004

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EXAMINER	
USTARIS, JOSEPH G	

ART UNIT	PAPER NUMBER
2611	7

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/699,554	NIHEI, KATSUMI	
	Examiner	Art Unit	
	Joseph G Ustaris	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 23 January 2004 in application 09/699,554.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5, 6, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. (US006332127B1) in view of Park (WO 96/04633).

Regarding claim 1, Bandera et al. discloses a system where advertisements or "advertisement data" are distributed or "broadcasting" to various users over the Internet. The advertisements are selected based on the time of day and/or user's location or "selection standards for a receive time, a receive position" (See column 7 lines 17-26). The advertisements can be stored on a local cache or "advertisement data base" of a mobile web client (See Fig. 6 element 27; column 9 lines 38-42). The mobile web client changes the advertisements when it detects a change of the time of day and/or user's location or "a reproduction time, a reproduction position" (See column 9 lines 3-19), where the mobile web client would load an advertisement that presents information about something that is closest to the current position of the user or displaying advertisements of "highest evaluation" (See column 7 lines 32-40). The advertisements

are presented to the user using web pages (See Fig. 6 element 26). However, Bandera et al. lacks a method where the user's preferences can be used in selecting advertisements and for the mobile web client to select and store advertisements from the "received advertisement data" that meet the selection criteria.

Park discloses an advertising system where advertisements can be selected based on the user-selected criteria or "preference of the user". The travel information device monitors the stream of data of a data broadcast or "received advertisement data" and filters out advertisements that does not satisfy the user-selected criteria and creates a database of advertisements that do meet the user-selected criteria (See Page 16 line 21 – Page 17 line 6). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement method disclosed by Bandera et al. to also select advertisements based on the user-selected criteria or "preference of the user" and for the mobile web client to filter or select and store advertisements from the "received advertisement data" that meet the selection criteria, as taught by Park, in order to provide advertisements that are of interest to the user and to filter out advertisements that the user doesn't take interest in, in addition to reducing the amount of processing performed by the server.

Regarding claim 2, certain advertisements are loaded and displayed only when the request for advertisements are made within certain time periods or "period of an advertisement" (See Bandera et al. column 7 lines 44-52).

Regarding claim 3, Park discloses a method where a distance-to-travel value or "fixed distance from said location" is calculated using the current position of the vehicle

and the position of the geographic point of interest or "advertisement target" (See Page 19 line 23 – Page 20 line 6).

Regarding claim 5, certain advertisements are loaded and displayed only when the request for advertisements are made within certain time periods or "period of an advertisement", wherein the certain advertisements are inherently given priority or "high evaluation" when requested within the time period (See Bandera et al. column 7 lines 44-52). It is assumed that if the request were made outside the certain time period, certain advertisements would not be loaded or given a "low evaluation".

Regarding claim 6, Bandera et al. discloses that the mobile web client would load an advertisement that presents information about something that is closest to the current position of the user or giving advertisements that presents information closest to the user "higher evaluation" (See column 7 lines 32-40). Therefore, advertisements that presents information that is far from the user's position is not loaded or given a "lower evaluation".

Claim 12 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Furthermore, Bandera et al. discloses that the advertisement system discussed in claim 1 may also be embodied as a computer program product on a computer-usable storage medium (See column 4 lines 29-35).

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. (US006332127B1) in view of Park (WO 96/04633) as applied to claims 1-3, 5, 6, and 12 above, and further in view of Hendricks et al. (US006408437B1).

Regarding claim 4, Bandera et al. in view of Park lacks a method where the user-selected criteria can store key words that are and are not of interest to the user.

Hendricks et al. discloses a set top terminal that receives programs or "advertisements" and is able to search through programs that contain key words, which are and are not of interest to the user. The key words can be stored within a downloaded thesaurus. Any programs that contain key words that are not of interest to the user are excluded (See column 31 lines 5-10 and column 32 lines 42-51). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the user-selected criteria disclosed by Bandera et al. in view of Park to be able to store key words that are and are not of interest to the user, as taught by Hendricks et al., in order to provide a more accurate filtering process when searching through programs or "advertisements".

Claim 7 contains the limitations of claim 4 and is analyzed as previously discussed with respect to that claim. Furthermore, programs that do contain all the key words of interest are listed or given a "higher evaluation", while programs that contain all the key words not of interest are excluded from the list or given a "lower evaluation" (See column 31 lines 5-10 and column 32 lines 42-51).

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. (US006332127B1) in view of Park (WO 96/04633) as applied to claims 1-3, 5, 6, and 12 above, and further in view of Barnett et al. (US006336099B1) and Rakavy et al. (US006317789B1).

Regarding claim 8, Bandera et al. in view of Park lacks a method where the advertisements are sent within a transmission package or "advertisement transmission row".

Barnett et al. discloses a distribution system for coupons and advertisements where the system can transmit to the user or user can download an advertisement package or "advertisement transmission row", wherein the advertisement package contains multiple coupons or advertisements of similar nature (See Fig. 10; column 12 line 29 – column 13 line 3). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement method disclosed by Bandera et al. in view of Park to include a system where multiple advertisements can be transmitted in a package or "advertisement transmission row", as taught by Barnett et al., in order to provide multiple advertisements for future use, thus enabling the mobile web client to make less frequent connections or transmissions for updating.

Claim 9 contains the limitations of claims 1-8 (wherein the system disclosed by Bandera et al. in view of Park is executed by a mobile web client or "advertisement receiver" and a web server or "advertisement transmitter") and is analyzed as previously discussed with respect to those claims.

Regarding claim 10, Bandera et al. in view of Park lacks a method where the advertisements that are expired and that have been displayed a certain number of times are deleted from the local cache of the mobile web client.

Rakavy et al. discloses an Advertisement Killer or "advertisement deletion processing" that purges advertisements that have been stored for a certain time or

"present time outside said period" and advertisements that have been displayed a number of times or "presented a number of times equal to said number" (See column 12 lines 60-67). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement method disclosed by Bandera et al. in view of Park to include an Advertisement Killer, as taught by Rakavy et al., in order to efficiently use the local cache or "advertisement data base" by freeing up more available space for newer advertisements.

Claim 11 contains the limitations of claims 8 and 9 (wherein the mobile web client disclosed by Bandera et al. in view of Park can also be labeled as an "advertisement receiver") and is analyzed as previously discussed with respect to those claims.

Response to Arguments

3. Applicant's arguments filed 23 January 2004 have been fully considered but they are not persuasive.

The objections to the specification are now withdrawn in view of the amendments.

With regards to claims 1 and 12, applicant argues that Bandera fails to show a selection process performed at the user/reception end of the transmission of the advertisement data. Admittedly, Bandera does not disclose this feature. However, Park does disclose a travel information device that selects advertisements from the data broadcast, wherein the travel information device is at the user/reception end of the system (See claim rejections).

Further, applicant argues that Bandera fails to evaluate and extract advertisements in an order of highest evaluation. However respectfully, Bandera with the teachings of Park discloses evaluating the advertisements stored within the local cache based on the latest time, position, and preference of the user (See Bandera Fig. 6). Furthermore, the mobile web client evaluates the contents of the lookup table according to the latest time, position, and preference of the user, and extracts only the advertisements that meet the criteria, thus giving the advertisements a higher evaluation. Therefore, when reading claims 1 and 12 in the broadest sense, Bandera with the teachings of Park meets all the limitations.

With regards to claim 2, applicant argues that Bandera fails to teach or suggest displaying an advertisement only if it is within a certain period. Although Bandera does disclose the use of validation anchors, Bandera also discloses that certain advertisements are loaded only in certain time periods without the use of validation anchors (See Bandera column 7 lines 40-52).

With regards to claim 7, applicant argues that Hendricks fails to teach or suggest giving a higher/lower evaluation based on the number of key words of interest and not of interest. The system, disclosed by Hendricks, presents only the programs that contain all the key words of interest, wherein the user can define more that one key word. Thus the programs listed are given a higher evaluation compared to the rest of the database. Hendricks also discloses that the system can work for negative searches, where if the user chooses one or more key words not of interest, the list would exclude all programs that contain all the key words thus giving those programs a lower evaluation (See Hendricks column 31 lines 10-30 and column 32 lines 40-55).

Applicant argues that Barnett fails to teach or suggest an "advertisement transmission row is transmitted". Barnett does disclose that coupon and advertising packages are stored at the online service provider. However, users can download those packages to their local computer, wherein it is inherent that the advertisement package or "advertisement transmission row" must be transmitted to the user's computer. The user is also mapped to multiple packages and thus can download multiple packages (See Barnett Fig. 1 elements 2 and 6, Fig. 10, and column 12 line 29 – column 13 line 3).

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Ustaris whose telephone number is (703) 305-0377. The examiner can normally be reached on Monday-Friday with alternate Fridays off from 7:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380. The fax phone number for this Group is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 305-4700.

JGU
March 25, 2004

VIVEK SRIVASTAVA
PRIMARY EXAMINER

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Paper No. 7

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 1/23/04 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see *68 Fed. Reg. 38611*, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

☑ 1. Amendments to the specification:
- ☑ A. Amended paragraph(s) do not include markings.
- ☐ B. New paragraph(s) should not be underlined.
- ☐ C. Other _____

☑ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
- ☑ B. Other Does not include markings.

☐ 3. Amendments to the drawings: _____

☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
- ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
- ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
- ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
- ☐ E. Other: _____

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf .

If the non-compliant amendment is a **PRELIMINARY AMENDMENT,** applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable**.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION (including a submission for an RCE),** and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION,** this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection**, and is not affected by the non-compliant status of the amendment.

_____ _____

Legal Instruments Examiner (LIE) Telephone No.